

## **REMARKS**

Claims 10, 12, 13, 15, and 16 have been canceled. New claims 26-28 have been added. Claims 19-22, 24, and 25 have been amended. No new matter has been added. Claims 2-6, 8, 9, 11, 14, and 17-28 are pending.

Applicants gratefully acknowledge and appreciate the patience and courtesies extended by Examiners Choi and Piziali in connection with the phone interviews, which did not take place as scheduled in accordance with the Interview Summaries mailed on 2/23/07 and 3/01/07.

### **35 U.S.C. § 112 Claim Rejections**

Claims 2-6, 8-14 and 17-25 were rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. Applicants' amendment obviates the basis for the rejection. In particular, Applicants have deleted the word "monolayer" from the claims. Accordingly, Applicants respectfully request withdrawal of this rejection.

Claims 24 and 25 were rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The rejected claims recite a personal care product comprising a biodegradable monolayer film stretched while in contact with an aqueous solution (claim 24) or a stretched biodegradable film (claim 25). According to the Examiner, the limitations referring to "stretching" the biodegradable film are not in the disclosure as originally filed, which only appears to suggest stretching a precursor film used to produce the biodegradable film, but not the biodegradable film itself.

Applicants' amendment obviates the basis for the rejection. In particular, Applicants have amended the claims so that the term "stretching" relates to a precursor film. Accordingly, Applicants respectfully request withdrawal of this rejection.

### **35 U.S.C. § 102 Claim Rejections**

#### **Zhao et al. (US 6,514,602)**

Claims 2-6, 8-14, and 17-21 were rejected as being anticipated by Zhao et al. (US 6,514,602; hereinafter "Zhao").

Newly amended claim 21 recites a biodegradable film formed from a stretched precursor film comprising a biodegradable polymer and a water soluble polymer, wherein the biodegradable film comprising from about 70% to about 95% biodegradable polymer by weight of the biodegradable film. Zhao fails to teach or suggest a biodegradable film formed from a stretched precursor film as claimed.

Zhao further fails to teach or suggest a biodegradable film according to claim 22 wherein the stretched precursor film comprises a blended mixture of the biodegradable polymer and the water soluble polymer and wherein the biodegradable film has a water vapor transmission rate of greater than about 2500 g/m<sup>2</sup>/24 hrs or in which the precursor film was stretched while in contact with an aqueous solution according to claim 24.

Applicants further disagree with the Examiner's assertion that Zhao's teaching of a film having a WVTR of at least about 1000 g/m<sup>2</sup>/24 hrs reads on Applicants' claimed range of greater than about 2500 g/m<sup>2</sup>/24 hrs. Nowhere does Zhao ever disclose, suggest, or provide an enabling disclosure for a film having a WVTR greater than about 2500 g/m<sup>2</sup>/24 hrs. Zhao merely discloses a multilayer film that is characterized as having a WVTR of at least about 1000 g/m<sup>2</sup>/24 hours. Zhao does not provide any evidence of a film having a WVTR of greater than about 2500 g/m<sup>2</sup>/24 hrs as claimed, nor does Zhao provide any reasonable expectation that the disclosed films would necessarily achieve a WVTR of greater than about 2500 g/m<sup>2</sup>/24 hrs. Zhao provides no more than an invitation to make and test a disclosed film to see whether it has a WVTR of greater than about 2500 g/m<sup>2</sup>/24 hrs.

MPEP 2112 requires a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic


necessarily flows from the teachings of the applied prior art. The Office fails to provide sufficient *prima facie* evidence to support an argument for inherency. The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish inherency of that result or characteristic: ("To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. In addition, inherency may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999)).

#### **New claims 26-28**

New claims 26-28 have been added to more particularly define additional aspects of the present invention. Inasmuch as the new claims recite the above-described limitations, they are distinguishable over the applied prior art for the above reasons.

It is believed that this application is now in condition for allowance. Such action is respectfully requested. If for any reason the Examiner feels that a discussion would be helpful, it is respectfully requested that the Examiner contact the undersigned agent directly at (312)-321-4233.

Respectfully submitted,



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